

Case: CT-2755 US - NP  
USSN 10/719,184REMARKSStatus of Claims

Claims 1 to 8 are pending in this application. Claims 1 to 3 are allowed. Claims 4, 5 and 6 stand rejected under 35 USC §112, second paragraph. Claims 5 and 6 stand rejected under 35 USC §112, first paragraph. Claims 7 and 8 are objected to as being dependent upon a rejected base claim.

REJECTION UNDER 35 USC §112, SECOND PARAGRAPH

The Examiner rejected claims 4, 5 and 6 under 35 USC §112, second paragraph, because the claim is of indeterminate scope.

Applicants have cancelled claim 5 and amended claims 4 and 6 and, as a result, this rejection is moot.

REJECTION UNDER 35 USC §112, FIRST PARAGRAPH

The Examiner rejected claims 5 and 6 under 35 USC §112, first paragraph, because the specification, while being enabling for migraine, pain, epilepsy and convulsions, does not reasonably provide enablement for remaining uses. More specifically, the Examiner cites an article written by Dr. Valentine K. Gribkoff and quotes specific sentences on page 742 of said article. Dr. Gribkoff is a colleague of the present applicants and was partly responsible for the biological work carried out in the KCNQ program for the compounds of the instant application.

In the interest of advancing this prosecution and providing a consistent response, Applicants have amended claim 4, cancelled claim 5 and amended claim 6 to clearly

define the diseases which pertain to the disorders related to the activity associated with KCNQ potassium channel activity.

Applicants believe that the claimed compounds would be useful for the diseases specifically identified in currently amended claim 6. To support this assertion, the Examiner is directed to Applicants' U.S. Patent 6,831,080 B2 to Wu, *et al.*, issued December 14, 2004. The present Applicants are co-inventors of U.S. 6,831,080 which discloses and claims another but different series of compounds useful in the treatment of the same disorders as claimed in the instant application that are responsive to the opening of the KCNQ potassium channels.

In columns 10 to 20 of said U.S. Patent '080, the Applicants described biological tests that confirmed the utility of such compounds (KCNQ modulators) for the disorders in currently amended claim 6 which include treatment of mania, bipolar disorders and anxiety.

It should also be noted that the control compound used in the neuropathic pain model, described in column 16 of Table 5 in said U.S. Patent '080, is gabapentin (Neurotin), a drug approved by the FDA for the treatment of convulsions, epilepsy and management of neuralgia (see Physician's Desk Reference).

In addition, the Examiner is directed to another application of Wu, *et al.*, which has the same priority date as the instant application and was issued by the USPTO on May 31, 2005, as U.S. Patent 6,900,210, and also allowed U.S. applications 10/719,188 and 10/719,187. The '210 patent claims a different series of compounds and claims a similar use for the disorders modulated by KCNQ channels as proposed herewith in amended claim 6. Unless the Examiner believes otherwise, Applicants, as well as Dr. Gribkoff, believe that the instant compounds would have the same utility based on art-

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recognized tests. Applicants believe the instant compounds would have the same utility based on the data presented in the specification.

In view of the foregoing amendments and remarks, Applicants believe that the rejections have been traversed and favorable action on the amended claims is respectfully solicited.

Respectfully submitted,

Date: June 1, 2006

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Enclosed: Petition for Time Extension  
Corrected Declaration

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SUBSTITUTE  
DECLARATION AND POWER OF ATTORNEY FOR U.S. PATENT APPLICATIONS

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name, and

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled

**ARYLCYCLOPROPYLCARBOXYLIC AMIDES**

**AS POTASSIUM CHANNEL OPENERS**

the specification of which was filed on **November 21, 2003** as U.S. Serial Number **10/719,184**.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims.

I acknowledge my duty to disclose all information which is known by me to be material to the patentability of this application as defined in 37 C.F.R. §1.56.

I hereby claim the benefit under 35 U.S.C. §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate listed below and under 35 U.S.C. §365(a) of any PCT international application(s) designating at least one country other than the United States listed below and have also listed below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States for the same subject matter and having a filing date before that of the application the priority of which is claimed for that subject matter:

None

I hereby claim the benefit under 35 USC §119(e) of any United States provisional application(s) listed below:

Application No.

Filing Date

60/428,337

November 22, 2002

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I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) listed below and under 35 U.S.C. §365(c) of any PCT international application(s) designating the United States listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in said prior application(s) in the manner required by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose all information known by me to be material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date(s) of the prior application(s) and the national or PCT international filing date of this application:

None

I hereby appoint the attorneys and agents associated with **Customer No. 23914**, respectively and individually, as my attorneys and agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Please address all communications to the address associated with **Customer No. 23914**, which is currently Stephen B. Davis, Bristol-Myers Squibb Company, Patent Department, P.O. Box 4000, Princeton, NJ 08543-4000.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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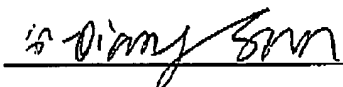
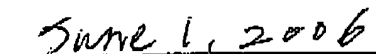
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IMPORTANT: Before this declaration is signed, the patent application (the specification, the claims and this declaration) must be read and understood by each person signing it, and no changes may be made in the application after this declaration has been signed.